IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Diab et al.
Appl. No.	:	09/111,604
Filed	:	July 7, 1998
For	:	SIGNAL PROCESSING APPARATUS
Examiner	:	Eric F. Winakur
Group Art Unit	:	3768

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/Jarom Kesler/
Jarom Kesler, Reg. No. 57,046

SUPPLEMENTAL PETITION UNDER 37 C.F.R. §1.181 FOR CORRECTION OF PATENT TERM EXTENSION

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R §§ 1.701(a)(1) and 1.701(c)(1)(i) and pursuant to 35 U.S.C. § 154(b), Applicants hereby Petition the Director under 37 C.F.R §1.181 to correct the patent term extension for the present application. See MPEP § 2720.

Introduction

The Issue Notification mailed on May 25, 2011 indicates that the present application will issue on June 14, 2011 as U.S. Patent No. 7,962,190, with a patent term extension under 35 U.S.C. § 154(b) of 681 days.

The present application was subject to an interference proceeding under 35 U.S.C. § 135(a), delaying issuance. The Board of Patent Appeals and Interferences ("the BPAI") resolved the initial interference in Applicant's favor. However, the junior party to the interference appealed the BPAI's decision to the Court of Appeals for the Federal Circuit ("the Federal Circuit"). This resulted in a lengthy appeal process, further delaying issuance due to the interference proceedings. The Federal Circuit upheld the Board's decision, again resolving the interference in Applicant's favor.

Where an appeal of an interference judgment is taken to the Federal Circuit, the interference terminates for the purposes of patent term extension only after the Federal Circuit renders a decision. *See* former 35 U.S.C. § 154(b) and 37 C.F.R. § 1.701; *see also* Federal Register / Vol. 60, No. 79, Tuesday, April 25, 1995 / Rules and Regulations at page 20204. Thus, Applicant is entitled to patent term extension not only for delay due to the initial interference, but also for delay due to the Federal Circuit appeal.

Here, the 681 days of patent term extension indicated by the Patent Office reflects only the amount of delay due to the initial interference at the BPAI, and does not reflect the at least 715 day delay due to the appeal to the Federal Circuit. As set forth herein, the patent term extension should be adjusted to at least 1396 days to account for the at least 715 day delay due to the Federal Circuit appeal.

Applicant is Entitled to at Least an Additional 715 Days of Patent Term Extension for Delay Due to the Federal Circuit Appeal

The present application was filed on July 7, 1998 and thus falls under former 35 U.S.C. 154(b) and 37 C.F.R. § 1.701 (pertaining to applications filed between 1995 and 2000). Former 35 U.S.C. § 154(b) reads, in part:

> (b) TERM EXTENSION.-
>
> (1) INTERFERENCE DELAY OR SECRECY ORDERS.-If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title ... the term of the patent shall be extended for the period of delay, but in no case more than 5 years. (See MPEP § 2720.)

37 C.F.R. § 1.701 reads, in part (emphasis added):

> (a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is ***entitled to extension of the patent term if the issuance of the patent was delayed due to:***
>
> ***(1) Interference proceedings under 35 U.S.C. 135(a)***;
>
> ...
>
> (c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:
>
> (i) With respect to each interference in which the application was involved, the number of days, if any, in ***the period beginning on the date the interference was declared or redeclared to involve the***

application in the interference and ending on the date that the interference was terminated with respect to the application;

Thus, Applicant is entitled to any delay due to interference proceedings, and the amount of delay begins on the date the interference was declared or redeclared and ends on the date that the interference was terminated.

Interference No. 105,477 was declared involving the present application on July 18, 2006.[1] The BPAI issued a judgment for the Interference that was favorable to Applicant on May 28, 2008. On July 30, 2008, the junior party to the interference appealed the BPAI judgment to the Federal Circuit. On May 14, 2010, the Federal Circuit issued its decision in Applicants favor as a mandate to the Patent Office, affirming the BPAI's initial judgment.

The amount of delay from the declaration of interference to the date of the initial BPAI decision was 681 days. The amount of delay from the BPAI decision to the Federal Circuit's issuance of the mandate following the appeal was 715 days. The May 25, 2011 Issue Notification indicates that the present application will issue with only 681 days of patent term extension, and does not include the 715 days of delay resulting from the appeal of the interference judgment to the Federal Circuit.

However, 37 C.F.R. § 1.701 states that a patent is "entitled to extension of the patent term if the issuance of the patent was delayed due to: (1) Interference proceedings under 35 U.S.C. 135(a)." Similarly, former 35 U.S.C. § 154(b) requires that extension be granted for delay "due to a[n] [interference] proceeding under section 135(a)." Where an appeal of an interference judgment is taken to the Federal Circuit, the delay is clearly due to an interference proceeding within the meaning of 37 C.F.R. § 1.701 and former 35 U.S.C. § 154(b). Thus, an interference terminates for the purposes of patent term extension only after the Federal Circuit renders a decision and issues its mandate to the Patent Office.

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[1] The Declaration of Interference and other documents and associated dates referred to herein can be found on the Image File Wrapper tab of the Patent Application Information Retrieval system of the USPTO website ("PAIR"). Applicant assumes that the Petitions Examiner has access to PAIR, and Applicant has therefore not provided copies of the documents along with this Petition. However, if the Petitions Examiner desires copies of such documents, Applicant will provide such copies upon request.

In addition, the Patent Office's interpretation of 37 C.F.R. § 1.701 clearly supports this reading. For example, the April 25, 1995 PTO Rule Notice recites, in part:

> An interference is considered terminated as of the date the time for filing an appeal under 35 U.S.C. 141 or civil action under 35 U.S.C. 146 expired. ***If an appeal under 35 U.S.C. 141 is taken to the Court of Appeals for the Federal Circuit, the interference terminates on the date of receipt of the court's mandate by the PTO***.

Federal Register / Vol. 60, No. 79, Tuesday, April 25, 1995 / Rules and Regulations at page 20204 (emphasis added).[2] Moreover, M.P.E.P. § 1216.01(I) recites, in part:

> In due course, the Clerk of the Federal Circuit forwards to the U.S. Patent and Trademark Office a certified copy of the court's decision. This certified copy is known as the "mandate." The mandate is entered in the file of the application, reexamination or interference which was the subject of the appeal. ***The date ** the mandate **>was issued by the Federal Circuit< marks*** the conclusion of the appeal, i.e., the termination of proceedings as that term is used in 35 U.S.C. 120. See 37 CFR 1.197(*>b<), or ***"termination of the interference" as that term is used in 35 U.S.C. 135(c)***. (Emphasis added; asterisks and other special characters in original.)

Thus, each of 37 C.F.R. § 1.701, former 35 U.S.C. § 154(b), the Patent Office's internal Rules and Regulations, and the M.P.E.P. dictate that delay caused by a Federal Circuit appeal of an interference decision is to be included in the patent term extension calculation.

As such, the patent term extension in the present case should be adjusted to include at least an additional 715 days of delay resulting from the appeal of the interference judgment to the Federal Circuit.

Conclusion

As set forth above, Applicants submit that the patent term extension for the present application should reflect the cumulative total of **1396 days** of delay due to interference proceedings pursuant to 37 C.F.R. § 1.701, not the indicated 681 days of delay. Applicant therefore request that the patent term extension be corrected to reflect at least this 1396 day amount.

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[2] Page 20204 of the cited PTO Rule Notice is being submitted herewith for the Petition Examiner's reference.

No fee is deemed due under 37 C.F.R § 1.181 as neither 37 C.F.R. § 1.181 nor 37 C.F.R. §1.701 indicate that a fee is due in conjunction with a Petition under 37 C.F.R §1.181. However, in the event that a fee is due, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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